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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,857	02/23/2004	Graham M. Chapman	PET 43.2-3 US	9434

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EXAMINER	
SHEWAREGED, BETELHEM	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/784,857	CHAPMAN ET AL.	
	Examiner	Art Unit	
	Betelhem Shewareged	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/508,028.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/508,028. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 1 and 2 the current invention are incorporated in claims 1 and 2 of 09/508,028. Claims 3-18 of the current invention are identical to claims 3-18 of 09/508,028.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 10 and 16-18 are objected to because of the following informalities:

a. In claim 10, the term "inherent cling" is not clear.

b. In claim 10, the term "inner surfaces of the material" is not clear. It is not if it is refereeing to the inner surfaces of the layers or the bottom layer.

c. In claim 16, it is not clear what the "post-consumer recycled material" comprises. The specification does provide any disclosure as to what the material comprises.

d. In claim 17, the term "dismissible" is not clear.

e. In claim 18, the use of the term " relatively weak" renders the claim ambiguous. The term is neither defined in the specification nor does it have a well defined meaning in the art. The necessary degree of weakness has not been defined.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (US 5,096,761).

Roberts discloses a co-extruded masking film comprising a HDPE layer (equivalent to the claimed inner layer), a LLDPE core layer and another EVA or HDPE layer (equivalent to the claimed outer layer) (col. 4, line 59 and col. 5, line 49 thru col. 6, line 57). No adhesive may be used when the film is used for masking (col. 15, line 11), and the masking film can be stored in rolls (col. 13, line 53). The masking film has an

overall enhanced tensile strength (col. 15, line 1), and fillers such as carbon black are used in the making film (col. 1, line 26). Roberts does not expressly disclose the claimed surface energy. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have irradiated the layer in order to provide a surface energy within the claimed range because the desire to improve a physical toughness of the layer from irradiation has been taught in col. 14, line 50 thru col. 15, line 10 of Roberts. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney,* 205 USPQ 215. To date, this burden has not been sustained.

With respect to claims 9 and 10, film size or thickness is properties, which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the sheet size or thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operating conditions (e.g., sheet size and thickness) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the amount or level of coverage that the masking sheet can provide and the mechanical strength and opacity of the film. Therefore, they are optimizable. At the time of the invention, it would have been obvious to one having ordinary skill in the art to make the masking sheet with the limitation of the sheet size since it has been held that

discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (US 5,096,761), as applied to claims 1-15 and 17, above, in further view of Gurewitz (US 5,364,695).

Gurewitz teaches a thermoplastic film comprising an outer HDPE layer, a LDPE core layer, and another HDPE inner layer, wherein the film has improved surface adhesion as a result of corona treatment of at 35 to 72 dynes (Abstract and col. 3, line 26). The LDPE core layer can include recycled plastic (col. 5, line 44). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make the core layer in the masking film of Roberts with recycled plastic because, as shown in Gurewitz, it is well known that masking films of improved surface adhesions can be effectively comprised of recycled plastics.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (US 5,096,761), as applied to claims 1-15 and 17, above, in further view of Cooper et al. (US 4,337,284).

Cooper teaches a film tear-tape comprising limitations of two or more layers of a thermoplastic LDPE substrate and an EVA layer wherein the tape can be torn at an angle to the plane of the film (col. 1, line 10). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make the masking film of Roberts

tearable since it is well known and also shown in Cooper that EVA, HDPE, and LLPE layers in a film can be torn for packaging purposes.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Betelhem Shewareged
March 18, 2005.